



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,477	12/18/2000	Cheng-Shing Lai	EM/LAI/6323	9333
7590 06/17/2004			EXAMINER	
BACON & THOMAS, PLLC			CALDWELL, ANDREW T	
4th Floor			ART UNIT	
625 Slaters Lane			2151	
Alexandria, VA 22314-1176			PAPER NUMBER	
			2	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/737,477

Applicant(s)

LAI ET AL.

Examiner

Andrew Caldwell

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Application/Control Number: 09/737,477  
Art Unit: 2151

### ***Remarks***

Claims 1-9 are pending.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the microprocessor mounted in a control circuit of the electronic device must be shown or the feature(s) canceled from claim 2. No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Making Email Talk With MIME, The UIC Academic Computing Center, [www.uic.edu/depts/accc/newsletter/adn13/mime.html](http://www.uic.edu/depts/accc/newsletter/adn13/mime.html), pp. 1-12, October 1996, hereinafter "UIC Reference."

Regarding claim 1, UIC Reference anticipates the claimed invention by disclosing a method comprising:

Storing at least one predetermined keyword in a first electronic device in advance, the keyword being related to one of a plurality of software installed in said first electronic device (pp. 1-12, particularly pp. 9-10 configuring MIME types in netscape – with Content-Type as a predetermined keyword, the combination being related to a particular application – e.g., Word Perfect);

Appending a keyword in an electronic message sent from a remote second electronic device to the first electronic device (pp. 1-12, particularly pp. 3-4 s);

Art Unit: 2151

Searching the predetermined keyword by a first microprocessor of the first electronic device after the electronic message is received (pp. 1-12, particularly);

Finding the predetermined keyword matched to the keyword contained in the electronic message (pp. 1-12, particularly);

Finding the software related to the predetermined keyword if there is a match between the predetermined keyword and the keyword contained in the electronic message (pp. 1-12, particularly p. 3 How You Do MIME showing automatic display of attachment and pp. );

Processing the electronic message by the related software (pp. 1-12, particularly p. 3 How You Do MIME showing automatic display; pp. 8-10 showing automatic display/processing by Word Perfect of a received Word Perfect file).

Regarding claim 6, the UIC Reference teaches a receiving process wherein each of the electronic devices is a computer (pp. 1-12).

Regarding claim 8, the UIC Reference teaches a receiving process wherein the electronic message is an e-mail (pp. 1-12).

Regarding claim 9, the UIC Reference teaches a receiving process wherein the electronic message is a short message (p. 2 What MIME Does – email messages as short messages).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the UIC Reference.

Regarding claim 2, the UIC Reference teaches the invention substantially as claimed. See the rejection of claim 1 above. As to the limitations of claim 2, they require the method steps 1 and 3-5 of claim 1 to be performed by a microprocessor mounted in a control circuit of the electronic device. The UIC Reference teaches that the sending and receiving of MIME messages are performed by personal computers (p. 11 The First: a Question). However, the UIC Reference does not specifically teach that the receiving personal computer processor is a microprocessor mounted to a control circuit. Official notice is hereby taken of the fact that personal computers have microprocessors mounted on mother boards/control circuits. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the generic PC shown by the UIC Reference to be a PC implemented using a microprocessor mounted on a motherboard because such a configuration is standard and cheaper.

Regarding claim 3, the UIC Reference teaches a method wherein the electronic message is processed by a typical receiving process when there is no keyword found in the electronic message (pp. 1-12 email without MIME content-type is received).

Regarding claim 4, the UIC Reference teaches a method wherein when no electronic message is received as determined by the microprocessor, the microprocessor performs the steps of determining whether there is a sent electronic message and ending the process if the determination is negative (pp. 1-12 implicit that a user agent sends no email message if none is pending); reading the attached keyword contained in the electronic message if the determination is positive (pp. 3-4 Sending a

Application/Control Number: 09/737,477

Art Unit: 2151

File); appending the attached keyword to the electronic message (p. 5 Sample MIME Message showing Content-Type in message); sending the electronic message to the remote second electronic device (pp. 3-4 Sending a File); and ending the process after sending (pp. 1-12 implicit that a user agent ends the process as defined by the claimed method steps after sending).

Regarding claim 5, the UIC Reference teaches a method wherein the electronic message is processed by the microprocessor by a typical sending process when no attached keyword is found in the electronic message as determined by the microprocessor (pp. 1-12)

Regarding claim 7, the UIC Reference teaches the invention substantially as claimed. See the rejection of claim 1 above. The UIC Reference does not specifically teach a method wherein each of the electronic devices is a mobile phone. Official notice is hereby taken of the facts that: (a) the use of mobile phones to receive email is known in the art and (b) mobile phones comply with Internet standards for receiving email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the UIC Reference's sender and receiver computers to be mobile phones compliant with Internet standards for sending and receiving email. This modification would have been obvious because it would allow the user to send and receive email anywhere.

### ***Conclusion***

A shortened statutory period for response to this action is set to expire **three months** from the mail date of this letter. Failure to respond within the period for



• Application/Control Number: 09/737,477

Page 8

Art Unit: 2151

response will result in **ABANDONMENT** of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Caldwell, whose telephone number is (703) 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m. EST.

If attempts to reach the examiner by phone fail, the examiner's supervisor, Glenton Burgess, can be reached at (703) 305-4792. Additionally, the fax numbers for Group 2100 are as follows:

Fax Responses: (703) 872-9306

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.



Andrew Caldwell  
703-306-3036  
June 12, 2004